

DEC 18 2006

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U.S. SERIAL NO. 09/542,632
PATENTREMARKS

Claims 1-20 were originally filed in the present application.

Claims 1-20 are pending in the present application.

Claims 1-20 were rejected in the October 19, 2006 Office Action.

No claims have been allowed.

Reconsideration of the claims is respectfully requested.

CLAIM REJECTIONS -- 35 U.S.C. § 103

Claims 1, 2, 5-7, 10-12, 16, 16, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No.6,587,684 to *HSU, et al.* (hereafter, "Hsu") and U.S. Patent No. 6,421,727 to *REIFER, et al.* (hereafter, "Reifer") and further in view of U. S. Patent No. 6,243,572 to *CHOW, et al.* (hereafter, "Chow").

Claims 3, 4, 8, 9, 13-15, 18, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Hsu and Chow and further in view of U. S. Patent No. 6,314,282 to *WEBER et al.* (hereafter, "Weber").

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

The Applicants direct the Examiner's attention to Claim 1, which contains the unique and novel limitations emphasized below:

1. For use in a wireless network comprising a plurality of base stations, each of said base stations capable of communicating with a plurality of mobile stations, a service provisioning system capable of provisioning a first one of said plurality of mobile stations comprising:
 - a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format; and
 - a provisioning controller coupled to said database capable of receiving a notification indicating that said first mobile station is unprovisioned and further capable, in response to receipt of said notification, of retrieving said service provisioning file from said database and transmitting said service provisioning file to said first mobile station, wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator. (*Emphasis added*).

The Applicants respectfully assert that the above-emphasized limitations are not disclosed in Hsu, Reifer, Chow, Weber, or any combination of them.

Reversing his previous position, the Examiner now concedes that Hsu does not teach this limitation. The Examiner makes no allegation that this limitation is taught by Chow or Weber, and

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indeed, they do not teach or suggest this limitation. The Examiner now relies on Reifer for this teaching.

Reifer is a satellite-based communications system that uses a browser system for service provisioning. The Examiner relies on col. 9, lines 7-15:

FIG. 9 is a diagram which illustrates the SPNet system of the present invention. In accordance with the present teachings, a browser at the Service Provider's location is used to download a JAVA application which, when executed, provides for service provisioning including service activation, suspension, reactivation and deactivation for telephone, paging, roaming and other services from a database at the GBS.

It is clear that neither this passage, nor any other passage in Reifer, teaches or suggests a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format, where the database must meet the other limitations of claim 1. For example, claim 1 requires that the provisioning controller is coupled to the database – there is no provisioning controller coupled to Reifer's "GBS".

The Examiner now responds that

In the Reifer reference, the examiner equates the "provisioning controller" to the SPNET system/server, which is clearly coupled to the GBS database in col. 9, line 7-10. Furthermore, the Examiner shows that the SPNet system can execute "service activation, suspension, reactivation..etc." [sic] (col. 9, lines 10-15). In addition, the Reifer reference teaches the "service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format" since the file downloaded from the GBS service is JAVA application, which by definition, [sic] is a form of interpreted byte-code format. The database and controller in Reifer can definitely replace the database and controller in the Hsu reference in order to

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expand the capabilities of the system in Hsu simply by the addition of JAVA enabled software.

The passages cited by the Examiner are reproduced above. As can be seen, the Examiner's "equating" of Reifer's SPNet "system/server" is unsupported. To the extent that the Examiner is alleging that the entire "SPNet system" of Reifer's Fig. 9 is the claimed "provisioning controller", it is clear that this is ridiculous, as this would include a browser, the entire Internet, the SPNet server, the GBS database, and the mysterious "QA KV", which is not described at all by Reifer.

To the extent, then, that the Examiner merely intends to equate the SPNet Server of Figure 9 with the claimed provisioning controller, it is clear that the limitations of claim 1 are not met. Nothing in Reifer teaches or suggests that the SPNET Server is capable of receiving a notification indicating that a first mobile station is unprovisioned. Nothing at all. The SPNet Server is described starting at col. 8, line 63:

SPNet Server--The SPNet Server is a C++ server process that provides the SPNet client with the CORBA interface necessary for creating, reading, updating, and deleting data in the GBS database. The GBS business objects communicate with the GBS database by executing stored procedures. The GBS business objects include a database connection manager that supports GBS business object to GBS database communication. The database connection manager is a C++ object that manages a pool of persistent database connections. The server also provides service request confirmations through an email notification process. ... [portion reproduced above is omitted]

The SPNet Server supports the SPNet Client, the QSSI, and the VSP applet. The SPNet Server is modified to support SSL security and

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additional VSP methods. The VSP applet is a lightweight version of the SPNet Client. It provides SSL security, public validation methods, and provides add customer and add contract methods. The JAVA script provides the mechanism to execute methods on the VSP applet. The HTML page provides the form for the end user to fill in the acts as a holder for the JavaScript and VSP applet. Finally, the Browser provides a mechanism for end users to travel to the GBS Web Site, load the HTML page, and execute JavaScript or Java commands.

As can be seen, the SPNet server is not taught as receiving a notification of an unprovisioned mobile station.

Nothing in Reifer teaches or suggests that the SPNET Server is capable, in response to receipt of said notification, of retrieving a service provisioning file from a database – Nothing in Reifer teaches or suggests a provisioning file in the GBS database.

Nothing in Reifer teaches or suggests the SPNet server transmitting a service provisioning file to a mobile station, as claimed. Reifer generally teaches that “a browser at the Service Provider’s location is used to download a JAVA application” from the SPNet server, but not that the browser is a mobile station, or that the JAVA application is stored in the GBS database.

Further, it is clear that even if Hsu’s database 28 (alleged by the Examiner to correspond to the claimed database in the November 3, 2005 Office Action) were modified according to Reifer to include a “JAVA application which, when executed, provides for service provisioning including service activation, suspension, reactivation and deactivation for telephone, paging, roaming and other services”, it would not be operable in Hsu’s system. Nothing in Hsu, Chow, or Weber teach or

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suggest that the mobile station is even capable of executing a JAVA application, and so Reifer's application cannot, in fact, be executed in the proposed system of Hsu, Chow, and Weber.

The Examiner responds by stating essentially that Hsu, Chow, and Weber could be modified by "the addition of JAVA enabled software". There is no teaching or suggestion in any of these references that this could be done, and there is certainly no motivated teaching or suggestion that it should be done. Indeed, the Examiner has no support at all for his bare assertion that "The database and controller in Reifer can definitely replace the database and controller in the Hsu reference in order to expand the capabilities of the system in Hsu simply by the addition of JAVA enabled software." Reifer's database and controller are not taught or suggested to perform as claimed, so such a combination would not meet the claim limitations, and this statement by the Examiner relies on a new, completely unsupported and unmotivated suggestion of an additional modification to the cited art. This is a legally and factually deficient rejection.

Claim 1 also requires that receipt of the service provisioning file causes said first mobile station to automatically execute the mobile station service provisioning program. Nothing in the art of record teaches this feature.

The Examiner relies on Chow for this teaching, at col. 2, lines 32-45:

The subscriber buys their phone at a retail outlet and the retail outlet records the purchase in a service provider database. The point-of sale information may include subscriber name, address, credit card number, unique mobile station identification number (MIN), optional personal identification number (PIN) and other verification number. The user activates their service by activating their phone over-the-air when they first communicate from their selected home neighborhood zone. The system automatically verifies the user by comparing the

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point-of-sale information with the information input by the subscriber from their home neighborhood zone. Over-the-air activation occurs without the assistance of service personnel.

Nothing in this passage teaches or suggests that receipt of a service provisioning file causes a first mobile station to automatically execute a mobile station service provisioning program. Here, the only thing done "automatically" is by the system, not the mobile station. This passage expressly requires that information be input by the subscriber, presumably into the mobile station. No art of record teaches or suggests the limitation of "wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator" as required by claim 1.

The Examiner responds by stating that

... it could be easily assumed that the system automatically verifying the user causes the mobile station to automatically activate the provisioning file. The above cited passage (col. 2, lines 33-45) does not state that the user do anything other than activate the phone for the first time, so it can be assumed that since the user does not have to do any further action, the mobile phone "automatically" executes a service provisioning file.

First, the Examiner's "can be assumed" argument is completely without merit. The Examiner is required to show that each limitation is actually taught in one or another of the references, and is not free to dismiss this legal obligation by a mere allegation that the teachings "could be assumed".

Further, the Examiner's statement that these assumptions can be made simply because there

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is nothing to the contrary in a 13-line selection from Chow is also baseless. The Examiner here purports to show the limitation that receipt of a service provisioning file causes a first mobile station to automatically execute the mobile station service provisioning program is "assumed" because these 13 lines don't say it doesn't happen. These 13 lines don't teach or suggest anything about a service provisional file being received by the mobile station, or that it is executed at all. Chow does not teach a service provisioning file; Chow does not teach a provisioning file received by the mobile station; and Chow does not teach that this reception causes the mobile station to automatically execute a mobile station provisioning program. In fact, Chow does not appear to teach or suggest that the mobile station is even capable of executing a program. This rejection is legally and factually deficient, and this can be discussed at length if applicant is forced to appeal a second time.

Finally, there is no proper motivation to combine Reifer with the other references. The motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) emphasis added). "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary

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skill in the field of the invention." (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added).

There is not specific motivation in the art, or even alleged by the Examiner, to incorporate Reifer's JAVA application into the proposed combination system of Hsu, Weber, and Chow. None of these other references could even execute it, and there is no teaching in the art that such a modification would provide any advantage at all. The Examiner's alleged motivation, "in order to enable the device to easier adapt to more recent technology" is completely unsupported in the art, and is not specifically related at all to the proposed modification, as required. Further, this general statement of motivation isn't even correct – if "more recent technology" does not provide any known advantage in a given system, and there is no evidence in this case that it would do so, then modifying a system to incorporate the "more recent technology" is an unnecessary and wasted expense.

For these reasons, the Applicants respectfully assert that neither Hsu, Chow, Reifer, nor Weber, nor any combination of the cited references teaches, a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format that is automatically executed when received by a mobile station. This being the case, Claim 1 presents patentable subject matter over all art of record. Additionally, dependent Claims 2-5, which depend from Claim 1, contain all of the unique and novel limitations recited in independent Claim 1. Claims 2-5 are therefore patentable over all art of record.

Furthermore, independent Claims 6, 11 and 16 recite limitations that are analogous to the unique and novel limitations recited in Claim 1. This being the case, Claims 6, 11 and 16 are

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patentable over all art of record. Dependent Claims 7-10, 12-15 and 17-20, which depend from Claims 6, 11 and 16, respectively, contain all of the unique and novel limitations recited in independent Claims 6, 11 and 16. Thus, Claims 7-10, 12-15 and 17-20 are patentable over all art of record.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

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SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at jmockler@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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